

PATENT

Atty. Dkt. No. WEAT/0389

REMARKS

This is intended as a full and complete response to the Final Office Action dated August 19, 2005 the Advisory Action dated September 29, 2005, having a shortened statutory period for response set to expire on November 19, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 29-43 are rejected and claims 15-28 are indicated to be allowable by the Examiner.

Claims 15-29 and 42-43 remain pending in the application after entry of this response. Claims 30-41 have been cancelled by Applicants without prejudice. Claims 29 and 43 have been amended. No new matter has been added by the amendments. Reconsideration of the rejected claims is requested for reasons presented below.

In the Advisory Action dated September 29, 2005, the Examiner did not enter the First Response to the Final Office Action dated August 19, 2005 (First Response) because the Examiner believed the First Response raised new issues that would require further consideration and/or search. Specifically, the Examiner asserted that new claim 44 raised a new issue. The Examiner recognized that merely incorporating claim 40 into claim 29 did not raise a new issue; however, the Examiner asserted that the other existing dependents thereof (claims 30-39 and 41) raised a new issue resulting from the incorporation. In response, Applicants have canceled claims 30-39 and 41 and have not re-presented claim 44. Applicants believe that this Second Response does not raise new issues and requests consideration and entry thereof by the Examiner.

Claim Rejections – 35 USC § 112

Claim 43 stands rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. Applicants have amended claim 43 to remove "second". Applicants believe this may have caused some confusion. Applicants had intended the overshot tool to be the "first" tool and labeled the additional tool a "second" tool. Applicants describe running a tool through the overshot tool at paras. [0017] and [055] of the published application (U.S. 2004/0256871).

Page 6

401136_1

PATENT

Alty. Dkt. No. WEAT/0389

Claim Rejections – 35 USC § 102

Claims 29-33, 35, 36, 38 and 39 stand rejected under 35 U.S.C. 102(b) as being anticipated by *Chenoweth* (U.S. 3,199,906). Applicants have amended claim 29 to incorporate claim 40. Claims 30-33, 35, 36, 38, and 39 have been canceled. Withdrawal of the rejection is respectfully requested.

Claim Rejections – 35 USC § 103

Claims 29-34, 36-38, and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Beeman* (U.S. 5,242,201) in view of *Taylor* (U.S. 5,765,638). Applicants respectfully traverse the rejection. Claims 30-34, 36-38, and 40-41 have been canceled.

Regarding claim 29, *Beeman* does not teach, suggest, or disclose either "a gripping member disposed in the housing and comprising: an inclined outer surface which mates with the inclined inner surface of the housing," or "wickers disposed along the inner surface of the gripping member," as recited in claim 29. *Taylor* does not teach, suggest, or disclose "a piston disposed in the housing and coupled to the gripping member, the piston disengaging the gripping member from the item when actuated by fluid pressure," as recited in claim 29.

There is no motivation to combine *Beeman* with *Taylor*. The Examiner asserts that the motivation to combine is to provide inclined outer surfaces to *Beeman*'s overshot tool in order to increase the gripping area of the tool. Adding inclined surfaces to the outer surfaces of the collet heads would not increase the gripping area. Combining *Taylor* with *Beeman* would also contradict a primary teaching of *Beeman*. *Beeman* teaches an overshot tool for fish having a well-defined receiving profile (i.e. groove 98) for receiving collet heads 92. *Beeman* relies on the collet heads being received in the groove to couple the overshot tool to the fish. While this may be suitable for retrieving tools having such a profile, it is ill suited for fishing drill pipe, tubing, casing, etc. Failure of these members may leave an irregular profile not suited for receiving collet heads.

PATENT

Atty. Dkt. No. WEAT/0388

Further, *Beeman* teaches away from a combination with an overshot tool having slips, such as *Taylor's* (*Taylor* teaches an improved washout seal for a Bowen-type overshot tool). In his Background section, *Beeman* surveys the prior art (about 20 references) and concludes that the art teaches hydraulically/mechanically set slips releasable by breaking some sort of shear element. *Beeman* never comments on why he chooses collets over slips but he does recognize a shortcoming of the collets: little/no torque transmission capability. Rather than propose an alternative design with slips, he adds lugs to his design to rectify the problem (Figs. 9 and 10). This further complicates the required profile of the fish (see above). Therefore, claim 29 is patentable over *Beeman* in view of *Taylor*.

Regarding claim 42, *Beeman* and *Taylor*, either alone or in combination, do not teach, suggest, or disclose either "injecting a fluid through the workstring, the overshoot tool, and the item, wherein the fluid will be choked by the item, thereby actuating the piston to disengage the gripping member from the item," as recited in claim 42. Further, *Beeman* does not teach, suggest, or disclose "pulling the workstring, thereby actuating the gripping member from a partially engaged position to an engaged position;" and *Taylor* does not teach, suggest, or disclose "providing the overshoot tool, comprising a ... a piston," as recited in claim 42.

Beeman does not specifically disclose how the pressure drop is achieved to actuate the collet ring 74 (or 20 for the spear embodiment). However, it is evident from *Beeman's* drawings that he disposes a nozzle at the end of tapered segment 56 for his spear embodiment (Figs. 1-4) and has a reduced inner diameter portion (unnumbered) at the end of the mandrel 10 for his overshoot embodiment (Figs. 5-8). (See also paras. [0015]-[0018] of the Application (U.S. 2004/0256871).) Further *Beeman* does not disclose a sealing element of any kind for engagement with the fish. Thus, *Beeman* is not utilizing the fish to provide a choke for his piston. *Taylor* does not teach, suggest, or disclose any kind of piston to actuate. Therefore, claim 42 is patentable over *Beeman* in view of *Taylor*.

PATENT
Atty. Dkt. No. WEAT/0389

Conclusion

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed. Having addressed all issues set out in the Final Office Action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



Jason Huang
Registration No. 46,222
PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicant(s)